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Anthony Miles

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BANNER & WITCOFF, LTD.

1100 13th STREET, N.W.

SUITE 1200

WASHINGTON, DC 20005-4051

EXAMINER

KIM, JUNG W

ART UNIT

PAPER NUMBER

2432

MAIL DATE

DELIVERY MODE

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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/506,964

**Applicant(s)**

MILES, ANTHONY

**Examiner**

JUNG KIM

**Art Unit**

2432

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-35 is/are pending in the application.
- 4a) Of the above claim(s) 11-35 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 5, 9 and 10 is/are rejected.
- 7) ☒ Claim(s) 2-4 and 6-8 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-946)
- 3) ☒ Information Disclosure Statement(s) (PTO/CDC)
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date: \_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_
- Paper No(s)/Mail Date: \_\_\_\_

### **DETAILED ACTION**

1. Claims 1-35 are pending.
2. Applicant's election without traverse of Group I corresponding to claims 1-10 in the reply filed on 5/4/09 is acknowledged. Hence, claims 11-35 are withdrawn.

#### ***Information Disclosure Statement***

3. The IDS submitted on 9/8/04 and 10/17/07 have been considered. Initialed copies are enclosed.

#### ***Double Patenting***

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

5. Claims 1-10 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-50 of copending Application No. 20060280050. Although the conflicting claims are not identical, they are not patentably distinct from each other because the limitations of claims 1-10 are defined in claims 1-50 of copending Application No. 20060280050.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

#### ***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claims 1, 5, 9 and 10 are rejected under 35 U.S.C. 102(e) as being anticipated by Heylen et al. US 20020159591 (hereinafter Heylen).

8. As per claim 1, Heylen discloses a compact disc carrying at least a first session including a table of contents and a program area containing at least one track, the table of contents indicating a start position (ATOC) of said track, and the program area including a subchannel (P; CTRL; IDX; PTIME) (paragraphs 51 and 56, as per Red

book and Yellow book standards); characterized in that said track includes, at said indicated start position (ATOC), a data portion (ED) containing unrecoverable data (paragraphs 70-74, Atime, Ttime and CRC information are invalidated); the subchannel (P; CTRL; IDX; PTIME) indicates a payload start position (AP) subsequent to the data portion (ED) (in red book standards, P subchannel indicates the start of audio); and c. said track includes a recoverable payload (PD) at the payload start position (AP) (Paragraph 8, remainder of the track remains intact, enabling reproduction by audio player but not necessarily via a cd-rom drive).

9. As per claims 5, 9 and 10, Heylen discloses a method of manufacturing a compact disc, comprising formatting source data to create a first session including a table of contents and a program area containing at least one track, the table of contents indicating a start position (ATOC) of said track, and the program area including a subchannel (P; CTRL; IDX; PTIME) (paragraphs 51 and 56, as per Red book and Yellow book standards); and recording the formatted source data on the compact disc; characterized in that said track includes, at said indicated start position (ATOC), a data portion (ED) containing unrecoverable data (paragraphs 70-74, Atime, Ttime and CRC information are invalidated); the subchannel (P; CTRL; IDX; PTIME) indicates a payload start position (AP) subsequent to the data portion (ED) (in red book standards, P subchannel indicates the start of audio); and said track includes a recoverable payload (PD) at the payload start position (AP). (Paragraph 8, remainder of the track remains intact, enabling reproduction by audio player but not necessarily via a cd-rom drive).

10. wherein the compact disc is a compact disc master (M); including manufacturing one or more playable compact discs directly or indirectly from the compact disc master (paragraph 24 and 25, data alteration is performed before audio mastering).

11. Claims 1, 5, 9 and 10 are rejected under 35 U.S.C. 102(e) as being anticipated by Babowicz US 20080212441 (hereinafter Babowicz).

12. As per claim 1, Babowicz discloses a compact disc carrying at least a first session including a table of contents and a program area containing at least one track, the table of contents indicating a start position (ATOC) of said track, and the program area including a subchannel (P; CTRL; IDX; PTIME) (paragraph 32, as per Red book and Yellow book standards); characterized in that said track includes, at said indicated start position (ATOC), a data portion (ED) containing unrecoverable data (paragraphs 58-74, Atime and CRC information are invalidated); the subchannel (P; CTRL; IDX; PTIME) indicates a payload start position (AP) subsequent to the data portion (ED) (in red book standards, P subchannel indicates the start of audio); and c. said track includes a recoverable payload (PD) at the payload start position (AP) (Paragraph 74, remainder of the program area remains intact, enabling reproduction by audio player but not necessarily via a cd-rom drive).

13. As per claims 5, 9 and 10, Babowicz discloses a method of manufacturing a compact disc, comprising formatting source data to create a first session including a table of contents and a program area containing at least one track, the table of contents

indicating a start position (ATOC) of said track, and the program area including a subchannel (P; CTRL; IDX; PTIME) (paragraph 32, as per Red book and Yellow book standards); and recording the formatted source data on the compact disc; characterized in that said track includes, at said indicated start position (ATOC), a data portion (ED) containing unrecoverable data (paragraphs 58-74, Atime and CRC information are invalidated); the subchannel (P; CTRL; IDX; PTIME) indicates a payload start position (AP) subsequent to the data portion (ED) (in red book standards, P subchannel indicates the start of audio); and said track includes a recoverable payload (PD) at the payload start position (AP). (Paragraph 74, remainder of the program area remains intact, enabling reproduction by audio player but not necessarily via a cd-rom drive).

14. wherein the compact disc is a compact disc master (M); including manufacturing one or more playable compact discs directly or indirectly from the compact disc master (paragraph 29, data modification is performed before audio mastering).

15. Claims 1, 5, 9 and 10 are rejected under 35 U.S.C. 102(e) as being anticipated by Shavit et al. US 6,952,479 (hereinafter Shavit)

16. As per claim 1, Shavit discloses a compact disc carrying at least a first session including a table of contents and a program area containing at least one track, the table of contents indicating a start position (ATOC) of said track, and the program area including a subchannel (P; CTRL; IDX; PTIME) (col. 3:33, as per Red book and Yellow book standards); characterized in that said track includes, at said indicated start position

(ATOC), a data portion (ED) containing unrecoverable data (15:36-50, Sync codes are inverted); the subchannel (P; CTRL; IDX; PTIME) indicates a payload start position (AP) subsequent to the data portion (ED) (in red book standards, P subchannel indicates the start of audio); and c. said track includes a recoverable payload (PD) at the payload start position (AP) (15:45-50, remainder of the program area remains intact, enabling reproduction by audio player but not necessarily via a cd-rom drive).

17. As per claims 5, 9 and 10, Shavit discloses a method of manufacturing a compact disc, comprising formatting source data to create a first session including a table of contents and a program area containing at least one track, the table of contents indicating a start position (ATOC) of said track, and the program area including a subchannel (P; CTRL; IDX; PTIME) (col. 3:33, as per Red book and Yellow book standards); and recording the formatted source data on the compact disc; characterized in that said track includes, at said indicated start position (ATOC), a data portion (ED) containing unrecoverable data (15:36-50, Sync codes are inverted); the subchannel (P; CTRL; IDX; PTIME) indicates a payload start position (AP) subsequent to the data portion (ED) (in red book standards, P subchannel indicates the start of audio); and said track includes a recoverable payload (PD) at the payload start position (AP). (15:45-50, remainder of the program area remains intact, enabling reproduction by audio player but not necessarily via a cd-rom drive).



18. wherein the compact disc is a compact disc master (M); including manufacturing one or more playable compact discs directly or indirectly from the compact disc master (15:63-16:29, data modification is performed to the master disc).

19. Shavit further discloses a method and compact disc to enable only authorized computers to read the audio data from a compact disc, whereby encrypted replica audio data is stored in a second session of the disc. Authorized software separate from the disc includes instructions regarding where to find the encrypted replica data on the disc and how to decode it for playback. Shavit does not disclose a pointer to a player program located in a data portion containing unrecoverable data of the first session.

20. Alcalay et al. US 6,988,206 discloses a method and compact disc for preventing CD piracy on a multi-session CD. In Alcalay, audio content is compressed and encrypted, and then stored on a second session of the CD; this encrypted data can be decrypted by software located in the second session. Col. 7:28-41. However, Alcalay does not disclose a pointer to a player program located in a data portion containing unrecoverable data of the first session.

21. Edwards WO 00/74053 discloses a method and compact disc for preventing a computer from reading a CD by encoding incorrect control data (navigation, timing, Atime in the Lead-in, and TOC) onto the disc. Pgs. 2-4.

22. Halderman "Evaluating New Copy-Prevention Techniques for Audio CDs" discloses several copy protection schemes, including schemes that place errors in the track data area, either in the subchannel codes or in the audio data and its error correction bits. Pg. 114, section 4.5.

***Allowable Subject Matter***

23. Claims 2-4 and 6-8 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

***Communications Inquiry***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jung W. Kim whose telephone number is 571-272-3804. The examiner can normally be reached on M-F 9:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gilberto Barron can be reached on 571-272-3799. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Jung Kim/  
Primary Examiner, AU 2432